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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte STEPHEN BUTZ

Appeal 2008-004388[1]
Application 09/976,481
Technology Center 2100

Decided: July 29, 2009

Before JOHN C. MARTIN, JEAN R. HOMERE, and
DEBRA K. STEPHENS, *Administrative Patent Judges*.

MARTIN, *Administrative Patent Judge*.

DECISION ON APPEAL

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[1] The real parties in interest are Stephen Butz, Social Solutions Corporation, and Living Classrooms Foundation. Supplemental Appeal Brief ("Br.") 1.

STATEMENT OF THE CASE

This is an appeal under 35 U.S.C. § 134(a) from the Examiner's rejection of claims 1 and 4-9, which are all of the pending claims.

We have jurisdiction under 35 U.S.C. § 6(b). We affirm-in-part and enter a new ground of rejection against claims 1 and 4-9.

A. Appellant's invention

Appellant's invention is described as "a method for the tracking and assessment of social services based on defining client barriers to success and then objectively tracking progress of the social worker based on the reduction and/or elimination of those barriers." Specification ¶ 0025.[2]

Appellant's Figure 1 is reproduced below.

[2] Because Appellant refers to the Specification of corresponding Patent Application Publication 2002/0152113 A1 rather than to the application as filed, so do we.

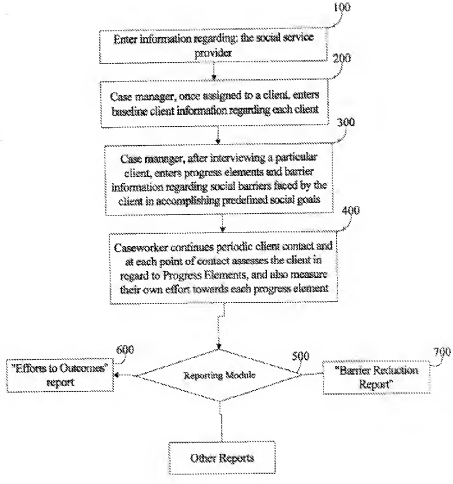

Figure 1 is a flow chart illustrating the general method steps according to Appellant's invention. *Id.* at ¶ 0013.

At step 100, the agency and/or individual case managers enter baseline information for each case worker inclusive of basic identifier information such as LastName, FirstName, Case Worker ID#, Employment Date, Position, and other informational fields as desired. *Id.* at ¶ 0027. At step 200, the individual case manager, once assigned to a client, enters baseline client information regarding each client inclusive of social security number, name address, ethnicity, gender, etc. *Id.* at ¶ 0028.

At step 300, the individual case manager, after interviewing a particular client, enters goal-oriented information regarding progress elements (points for improvement) as well as social barriers faced by the client in accomplishing predefined social goals. *Id.* at ¶ 0032.

For example, in the context of employment placement exemplary Progress Elements may include: Retention; New Employment; Wage Increase; Promotion; and Educational Advancement. *Id.* at ¶ 0033. In the same context (i.e., employment placement), an exemplary set of predefined Barriers can include: Day Care (whether the client requires day care for dependants); Transportation (whether the client requires transportation to/from work); Health Issues; Family Issues (e.g., divorce situation); Behavior (behavioral issues); Attitude; Weight; Personal Hygiene; Disability; Laziness; Money Management; Lack of Skills; and Literacy. *Id.* at ¶ 0036.

At step 400, the caseworker continues periodic client contact and at each point of contact reassesses the client. *Id.* at ¶ 0039. As explained in paragraph 0033 and shown in block 400 in Figure 1, the caseworkers "also measure their own effort towards each progress element."

Given a fully populated database as per steps 100-400, the caseworker and/or agency may initiate a reporting module as shown at step 500 which provides access to a predefined series of queries, the results of each query being displayed in a format conducive to the recipient of the information. *Id.* at ¶ 0042.

Figure 4 (not reproduced below) is a screen print of an exemplary Progress Element entry screen by which the caseworker can specify a Progress Element (career path/employment planning), and enter contact information (location, time, date of next update and notes) regarding the caseworker's own efforts toward facilitating the specified Progress Element. *Id.* at ¶ 0033. By this approach, caseworker efforts can be measured against the outcomes produced. *Id.*

Figure 12 (not reproduced below) is an example of a "Barrier Reduction Report" report (block 700 in Fig. 1) that details for three caseworkers each Barrier faced, the caseworker's Efforts Against Barriers, Severity of the Barrier, Start Date, and Time in Program (both days and weeks). *Id.* at ¶ 0045. The foregoing data is tabulated and a summary listing is provided, which includes Successful Client Barrier Reductions (1), Total Work Against Client Barriers (75 Minutes, 1.25 Hours), Number of Client Contacts (2), Successful Client Barrier Reductions (5), Total Work Against Client Barriers (782 minutes), and the total Number of Client Contacts (16). *Id.* This form of report ensures that the agency can provide caseworkers (or caseworkers can provide the agency) with quantitative

accountability for social services based on objective reduction of barriers.

Id.

B. Illustrative claim

Claim 1, the sole independent claim, reads:

> 1. A method for the storage and querying of social services data in a knowledge base that provides quantitative accountability for social services provided by a case worker to a client via a navigable user interface, comprising the steps of:
>
> collecting information relating to defined social services and providers;
>
> collecting information relating to defined clients;
>
> collecting information relating to defined client barriers to productivity;
>
> collecting information relating to defined goal-oriented client outcomes;
>
> incorporating said collected information into a structured relational database;
>
> providing a graphical user interface with a plurality of controls each for initiating a pre-determined query for allowing a user to generate a report indicating reduction of said client barriers over time, thereby maintaining quantitative accountability for social services.

Claims App., Br. 15.

C. The reference and rejections

The Examiner relies on the following reference:

Douglas et al. (Douglas)	US 6,039,688	Mar. 21, 2000

Claims 1 and 4-8 stand rejected under 35 U.S.C. §§ 102(a) and 102(e) for anticipation by Douglas.

Claim 9 stands rejected under § 103(a) for obviousness over Douglas.

THE ISSUES

Appellant has the burden to show reversible error by the Examiner in maintaining the rejections. *See In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006) ("On appeal to the Board, an applicant can overcome a rejection by showing insufficient evidence of *prima facie* obviousness or by rebutting the *prima facie* case with evidence of secondary indicia of nonobviousness." (citation omitted)).

Regarding the anticipation rejection of claim 1, Appellant argues that the Examiner erred in finding that Douglas:

(a) manages "social services";

(a) collects information relating to client barriers to productivity; and

(b) provides the recited "accountability."

Regarding dependent claims 4-9, Appellant contends that the Examiner erred in finding that Douglas satisfies various other limitations recited in claims 4-8 (addressed *infra*) and in concluding that the subject matter of claim 9 would have been obvious over Douglas.

PRINCIPLES OF LAW

Application claims are interpreted as broadly as is reasonable and consistent with the specification, *In re Thrift*, 298 F.3d 1357, 1364 (Fed. Cir.

2002), while "taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in the applicant's specification," *In re Morris*, 127 F.3d 1048, 1054 (Fed. Cir. 1997), and without reading limitations from examples given in the specification into the claims, *In re Zletz*, 893 F.2d 319, 321-22 (Fed. Cir. 1989).

WHETHER DOUGLAS MANAGES "SOCIAL SERVICES"

Douglas's invention is a computer-implemented system for promoting wellness and improving health and more particularly to a "therapeutic behavior modification program," compliance monitoring, and feedback system. Douglas, col. 1, ll. 14-18.

In an exemplary scenario, a physician prescribes parameters and goals for a therapeutic behavior modification program to help a patient recover from an ailment or surgical procedure, and these are input into the computer-implemented system. *Id.* at col. 2, ll. 23-27.

Douglas's system includes an interface that allows immediate patient access to the behavior modification program and helps monitor compliance with the program by prompting the patient to input data relating to his or her adherence to the program's parameters. *Id.* at col. 2, ll. 30-34. These parameters can relate, for example, to diet, exercise, and other factors pertinent to the behavior modification program. *Id.* at col. 2, ll. 34-36. The patient, physician, case manager, or members of the physician's staff may also input information relating to blood pressure, medication, and the results

of other medical tests on a computer linked to the system. *Id.* at col. 5, ll. 36-40. Using this input, the system can recommend a plan (also referred to as a therapeutic program) and goals based on established medical protocols and the physician can modify the program to customize it for the patient. *Id.* at col. 2, ll. 40-44.

Once the patient has begun to follow the program, the system recommends modifications and updates to both the physician and the patient by correlating the patient's progress with previously established goals. *Id.* at col. 2, ll. 44-47.

Individuals who can benefit from Douglas's system include those with chronic ailments such as coronary artery disease, diabetes, chronic pain, depression, addiction, arthritis, cancer, and asthma, as well as patients who are recovering from medical procedures such as angioplasty or by-pass surgery (the "clinical group"). *Id.* at col. 5, ll. 45-51. Individuals who simply want to maintain their health and prevent or reduce the risk of such ailments (the "wellness group") also can benefit from the program. *Id.* at col. 5, ll. 52-54. For these individuals, the program may be focused on stress management, diet, and exercise. *Id.* at col. 5, ll. 54-56.

As support for concluding that the claim term "social services" recited in claim 1 is broad enough to read on Douglas, the Examiner cites Appellant's discussion of what the Examiner characterizes as "patient care management" at pages 4 and 5 of the Application Specification (i.e., ¶¶ 0006, 0008 of the Patent Application Publication). Final Action 3 n.1. Paragraph 0006 describes "a need to develop a better system for the storage,

retrieval and interpretation of case management information, based on the barrier-mapping model, in order to track and help achieve optimal *clinical and financial patient outcomes*" (emphasis added). The same terminology appears in paragraphs 0008 and 0047, of which the latter paragraph also mentions "patient care management." Furthermore, as noted above, the Specification includes "Health Issues" in the "exemplary set of predefined Barriers." *Id.* at ¶ 0036.

Viewed in light of the above-quoted intrinsic evidence, particularly the inclusion of "Health Issues" in the "exemplary set of predefined Barriers," we conclude that a person having ordinary skill in the art would have interpreted "social services" as used in claim 1 to be broad enough to include health issues of the type that are the subject of Douglas's behavior modification program, such as the health of "[i]ndividuals who simply want to maintain their health and prevent or reduce the risk of such ailments (the 'wellness group')." Douglas, col. 5, ll. 52-54.

Appellant's arguments to the contrary are not persuasive. As support for the argument that Douglas's therapeutic behavior modification program is not a "social service," Appellant asserts that "Merriam Webster defines 'social service' as an activity designed to promote social well-being; specifically: organized philanthropic assistance (as of the disabled or disadvantaged)." Br. 8. This argument is unpersuasive because the concept of "promot[ing] social well-being" recited in this definition is broad enough to include health matters. On the other hand, assuming for the sake of argument that this definition excludes health matters, reliance on that

definition would be improper because it contradicts the Specification, which, as noted above, gives "Health Issues" as a type of barrier. *See Phillips v. AWH Corp.*, 415 F.3d 1303, 1322-23 (Fed. Cir. 2005) (en banc) (it is appropriate to rely on a dictionary definition when construing claim terms only so long as the dictionary definition does not contradict any definition found in or ascertained by a reading of the patent documents).

Appellant also argued that interpreting the term "social services" requires a recognition of the differences between the educational requirements of Douglas's "case advisor," who "may be a doctor, nurse, and/or other trained medical professional experienced in case management protocols and practices" (Douglas, col. 5, ll. 34-36), and the educational requirements of social workers, who typically have a bachelor's degree in social work (BSW) or may have majored in psychology, sociology, and related fields. Reply Br. 2-3. This argument, which was made for the first time in the Reply Brief, is entitled to no consideration because it was not necessitated by a new point in the Answer and thus should have been made in the opening Brief. *See Optivus Tech., Inc. v. Ion Beam Applications S.A.*, 469 F.3d 978, 989 (Fed. Cir. 2006) (argument raised for the first time in the reply brief that could have been raised in the opening brief is waived); *accord Ex parte Scholl*, No. 2007-3653, slip op. at 18 n.13 (BPAI March 13, 2008) (designated as "Informative Opinion"), *available at* http://www.uspto.gov/web/offices/dcom/bpai/its/fd073653.pdf. In any event, this argument is unpersuasive because it is unsupported by any evidence and "arguments of counsel cannot take the place of evidence

lacking in the record." *Estee Lauder Inc. v. L'Oreal, S.A.*, 129 F.3d 588, 595 (Fed. Cir. 1997) (citation omitted).

Nor are we persuaded by Appellant's new argument that "Appellant founded his company called *Social Solutions* Corporation which now sells its software at http://www.socialsolutions.com/ under the tagline 'We help organizations improve services to those in need by relating their efforts to desired outcomes.'" Reply Br. 3.

WHETHER DOUGLAS COLLECTS INFORMATION RELATING TO CLIENT BARRIERS TO PRODUCTIVITY

The Examiner reads the step of "collecting information relating to defined client barriers to productivity" on Douglas's Figures 5 and 45. Answer 3.

Douglas's Figure 5 is reproduced below.

Fig. 5

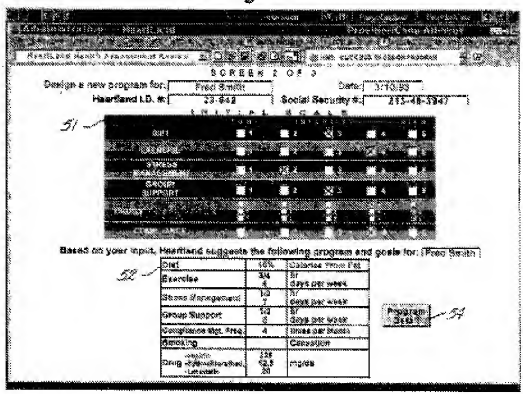

Figure 5 is a graphical representation corresponding to the program Design option of Figure 4. Douglas, col. 3, ll. 29-30.

After a patient's vital signs (e.g., weight, cholesterol level, blood pressure), other baseline characteristics (e.g., patient's smoking habit, physical activity, alcohol and eating habits, depression and stress levels, seat belt use), and information relating to any medications used by the patient have been entered into the system (*id.* at col. 6, l. 65 to col. 7, l. 5), the system prompts the physician or case advisor to assign intensity levels 51 (Fig. 5) ranging from 1 to 5 corresponding to the patient's diet, exercise,

stress management, need for group support, anticipated compliance, and pharmaceutical requirements. *Id.* at col. 7, ll. 15-21.

Based on the input information, the system, case advisor, or physician generates a set of goals 52 (Fig. 5) or milestones for the patient by correlating patient information such as age, sex, weight, and information relating to the health, life situation, and diagnostic category of the patient to established medical protocols for that type of patient. *Id.* at col. 7, ll. 23-28. The goals depicted in Figure 5 include target values for the intake of calories from fat, exercise level, stress management counseling, group support, and compliance management frequency.

The system can generate a health record (Fig. 40) that includes the patient's vital signs and other health-related factors, such as blood pressure 250, number of cigarettes smoked per day 252, amount of physical activity 254, weight 256, and cholesterol level 258, as measured or reported on different dates. *Id.* at col. 17, ll. 44-61.

The system generates reports on patient progress based on the data shown in Figures 40-45, as frequently as the physician desires. *Id.* at col. 18, ll. 26-28. Referring to Figure 40, a physician/case advisor is given an option 274 to assess the patient's behavior. *Id.* at col. 18, ll. 6-7. Upon selection of this option, the system provides a behavioral change assessment form 305 like the one shown in Douglas's Figure 45, reproduced below.

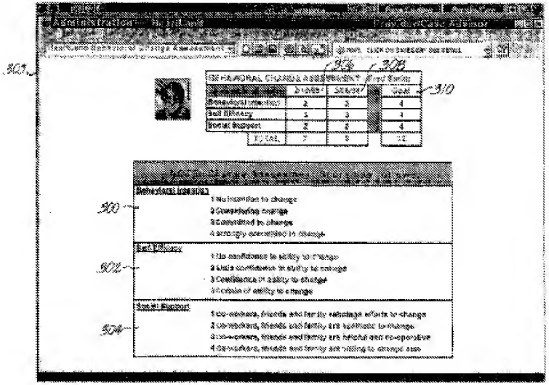

Fig. 45

Figure 45 is a graphical representation of the system's Behavior option. *Id.* at col. 4, ll. 50-51. Upon selection of this option, the system provides the behavioral assessment form 305 depicted in this figure in order to determine how inclined the selected patient is toward complying with the recommended program. *Id.* at col. 18, ll. 8-12. In the preferred embodiment, on-line questionnaires are submitted to the patients, asking them to rate their behavioral intention 300, self-efficacy 302, and social support 304. *Id.* at col. 18, ll. 12-15. For example, as shown in Figure 45, "behavioral intention" is rated or assessed on a scale of 1 to 4 as follows:

1. No intention to change.

2. Considering change.
3. Committed to change.
4. Strongly committed to change.

"Self-sufficiency" is likewise rated on a scale of 1 to 4:

1. No confidence in ability to change.
2. Little confidence in ability to change.
3. Confidence in ability to change.
4. Certain of ability to change.

The system periodically assesses (on a scale of 1 to 4) and reports the patient's behavioral change (i.e., assessment), as shown in columns 306 and 308 of Figure 45. *Id.* at col. 18, ll. 18-19. The goals 310 (likewise on a scale of 1 to 4) are also listed to monitor whether the patient is making progress towards them. *Id.* at col. 18, ll. 19-21. If a patient continues to score low on the behavioral change assessment form 305, this may indicate that he or she is unable to change his or her lifestyle and can lead to the conclusion that the patient should be taken off the system. *Id.* at col. 18, ll. 21-25.

The Examiner (Answer 3) reads the steps of "collecting information relating to defined client barriers to productivity" on Douglas's Figure 5 and on the patient's periodic self-assessments 306 and 308 of behavioral intention 300, self-efficacy 302, and social support 304 (Fig. 45). Appellant makes several arguments against the Examiner's position. One is that the behavioral intention, self-efficacy, and social support assessed in Douglas are not barriers, because "[a] 'barrier' is something immaterial that impedes or separates, e.g., an obstacle [Merriam Webster]." Br. 11 (second set of brackets in original). The Examiner responded, correctly in our view, that

the "intention and self-efficacy" monitored in Douglas satisfy this dictionary definition because "an obstacle may vary in intensity from a 'lack of confidence' (signifying a large barrier) to a 'certainty of an ability to change' (signifying little to no barrier)." Answer 8. This conclusion is also consistent with the fact that Appellant's Specification gives "low motivation to change" as an example of a "barrier to productivity." *See* Specification at ¶ 0005 ("For example, in career counseling, clients have specific 'barriers' to productivity including: a lack of belief in self; *low motivation to change*; belief that potential for success is low; finances (especially for clients in colleges and CECs); family responsibilities (especially for clients in college or working mothers); and unemployment." (emphasis added)).

For the foregoing reasons, we are also unpersuaded by Appellant's argument that one skilled in the art would not have considered behavioral intention, self-efficacy, and social support, which are assessed in Douglas's Figure 45, to be "barriers" because they are more like the claimed "goal-oriented client outcomes" recited in claim 1's step of "collecting information relating to defined goal-oriented client outcomes" (Br. 11).[3]

Because Appellant has not persuaded us that the Examiner erred in reading the recited "barriers to productivity" on behavioral intention and self-efficacy, which are assessed in Douglas's Figure 45 report, we do not reach the Examiner's alternative finding (Answer 3, 8-9) that the recited

[3] Appellant does not challenge the Examiner's finding (Answer 4) that the recited "goal-oriented client outcomes" read on goals 310 in Figure 45.

barriers read on the health factors listed in Douglas's Figure 5, including diet and exercise, to which a case worker or physician has assigned intensity levels on a scale of 1 to 5. Douglas, col. 7, ll. 15-22.

WHETHER DOUGLAS PROVIDES
THE RECITED "ACCOUNTABILITY"

The preamble of claim 1 calls for "provid[ing] quantitative accountability for social services provided by a case worker to a client via a navigable user interface," and the body of that claim calls for "collecting information relating to defined social services and providers" and "allowing a user to generate a report indicating reduction of said client barriers over time, thereby maintaining quantitative accountability for social services."

In response to the Examiner's finding that these limitations are satisfied by Douglas's Figures 39-45 (Final Action 4), Appellant argued that "Claim 1 is specifically limited to providing *quantitative accountability for social services provided by a case worker to a client*" and that "Douglas '688 does not teach or suggest any manner or means of tracking the physician's effectiveness, only the patient's progress." Br. 8. Appellant further argues that "[s]ince this system [of Douglas] is not concerned with provider accountability, the only information collected in regard to the case worker or physician is a password and username, as made clear by the Examiner's cited sections." Br. 9. We agree with the Examiner that claim 1 does not require that the report specifically track the effectiveness of the social service providers, i.e., expressly evaluate the effectiveness of the

social service providers. *See* Answer 7 ("[T]he claim language does not fairly convey to one of ordinary skill in the art Appellant's specific interpretations of 'tracking the physician's effectiveness' or 'provider accountability.'"). Although the report depicted in Appellant's Figure 12 does attribute barrier-reduction results to individual case workers, the claim language is broad enough to read on a report that provides, for one or more patients,[4] barrier-reduction results from which the effectiveness of the social service providers (either individually or as a group) can be inferred. The improvements in the periodic assessments 306 and 308 of behavioral intention 300 and self-efficacy 302 in Douglas's Figure 45 report inherently provide an indication of the effectiveness of the involved health care professionals in reducing the barriers represented by low assessments in those areas.

CONCLUSIONS REGARDING THE REJECTION OF CLAIM 1

Appellant has not demonstrated that the Examiner erred in finding that Douglas's behavior modification system:

(a) manages "social services";

[4] The phrase "a client" in the preamble of claim 1 is interpreted to mean "one or more clients," and the phrase "a case worker" in the preamble is interpreted to mean "one or case workers." *See Baldwin Graphic Sys., Inc. v. Siebert, Inc.*, 512 F.3d 1338, 1342 (Fed. Cir. 2008) ("[T]his court has repeatedly emphasized that an indefinite article 'a' or 'an' in patent parlance carries the meaning of 'one or more' in open-ended claims containing the transitional phrase 'comprising.'" (citation omitted)).

(a) collects information relating to client barriers to productivity; and

(b) provides the recited "accountability."

The anticipation rejection of claim 1 is therefore affirmed.

THE ANTICIPATION REJECTION OF DEPENDENT CLAIMS 4-8

Claim 4, which depends on claim 1, specifies that the step of collecting information relating to defined client barriers to productivity further comprises "selection of pre-defined itemized barriers to client productivity and for each itemized barrier a severity of said barrier." Appellant argues:

> If we construe Douglass [sic] at fig. 5, #51, fig. 45, scale from 1-4 (diet, exercise, stress management, need for group support, anticipated compliance, and pharmaceutical requirements) as being barriers to success as the Examiner suggests, then the designation of forward-looking intensity (scale of 1-4 for purposes of implementing a health regimen) cannot be equated to a designation of current barrier severity as required by claim 4.

Reply Br. 6. Appellant's characterization of Douglas's intensity ratings as "forward looking" is incorrect as applied to at least assessments 306 and 308 in Figure 45, which represent current self-assessments of behavioral intention 300, self-efficacy 302, and social support 304 made by the patient on different dates. Douglas, col. 18, ll. 6-17.

Appellant also argues:

> Severity is severity not intensity. As defined at page 17, line 6 of the specification "the corresponding severity is identified by a SeveritylD field which may be a scale of from 1 (lowest severity)

> to 10 (most severe)." It requires a designation of severity to track a gradual reduction of severity as required by claim 4.

Reply Br. 6-7. This argument, too, is unpersuasive. Claim 4 does not expressly or implicitly require more than three severity levels and thus reads on Douglas's intensity levels of 1-3, which as applied to behavioral intention, self-efficacy, and social support represent barrier severity.

We are therefore affirming the rejection of claim 4.

Claim 5 depends on claim 4 and further specifies that "said step of providing a graphical user interface with a plurality of controls each for initiating a pre-determined query further comprises a control for initiating a pre-determined query for allowing a user to generate a report assessing progress in reducing severity or eliminating said client barriers over time." Appellant argues that "nowhere does Douglas et al. report on any reduction *in barrier severity* as required by claim 5." Reply Br. 7. This argument fails to take into account that assessments 306 and 308 in Figure 45 increased from 2 to 3 in the areas of behavioral intention and social support. The rejection of claim 5 is therefore affirmed.

Claim 6, which depends on claim 1, further recites "a step of periodically collecting information measuring reduction of said defined client barriers" and claim 7, which depends on claim 6, further recites "a step of periodically collecting information specifying said case workers efforts toward reducing said defined client barriers to productivity over time." Although Appellant characterizes these claims as requiring "periodic *monitoring to measure reduction of said defined client barriers over time*"

(Br. 12), Appellant has not explained, and it is not apparent, why these claims do not read on periodic assessments 306 and 308 in Figure 45 of Douglas. The rejection of claims 6 and 7 is therefore affirmed.

The separate argument regarding claim 8 made at page 7 of the Reply Brief is entitled to no consideration because it did not appear in the opening Brief and was not necessitated by a new point in the Answer. *Optivus Tech.*, 469 F.3d at 989. The rejection of claim 8 is affirmed.

In summary, the anticipation rejection of claims 4-8 is affirmed.

THE OBVIOUSNESS REJECTION OF CLAIM 9

Claim 9 depends on claim 1 and specifies that "said step of collecting information relating to defined goal-oriented client outcomes further comprises selecting from a predefined categorical list of progress elements including any one from among the group consisting of job retention, finding a new job, wage increase, promotion, and educational advancement." The Examiner, addressing the meaning of claim 9, correctly concluded that "the claim requires only one element from the group" (an interpretation not challenged in the Reply Brief[5]) and selected the "educational advancement" element as the basis for the rejection. Answer 10.

[5] We are therefore treating as implicitly withdrawn Appellant's earlier argument that the predefined list of progress elements includes *all* of the elements recited in the claim. *See* Br. 13 ("Claim 9 requires collecting information relating to defined goal-oriented client outcomes from *a predefined categorical list of progress elements* including job retention,
(Continued on next page.)

Next, the Examiner, after finding that "Douglas discloses motivational factors as part of behavior modification, discussed above, and fig. 45, #300-#304" (Final Action 6) and that "Douglas states that education and motivation is a two-pronged approach to behavior modification (col. 14, ll. 10-12)" (Answer 10), concluded:

> Therefore, it would have been obvious to one of ordinary skill in the art to modify the prior art so that it can additionally monitor educational advancement. One of ordinary skill in the art would have been motivated to provide a clearer picture of a patient's overall progress, because the modification would allow both the education prong (e.g., progress of a patient's learning about himself/herself) and the motivation prong to be monitored.

Id. We agree with Appellant that "[t]he Examiner's logic provides no support for his proposition that one skilled in the art would include 'educational advancement' in the list of progress elements." Reply Br. 8. The reason is that the "two-pronged approach" language on which the Examiner relies is a characterization of Douglas's behavior modification system as a whole rather than a suggestion that the system can be used to monitor education:

> As will become more apparent from a detailed description of the system's other interfaces, the system takes a two-pronged approach to behavior modification: education and motivation. Entertainment is used as a means of both educating and motivating a user to make the sometimes difficult changes required for recovery or even for maintaining a healthy lifestyle.

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finding a new job, wage increase, promotion, and educational advancement.").

Douglas, col. 14, ll. 10-16.

We are therefore reversing the obviousness rejection of claim 9.

DECISION

The rejection of claims 1 and 4-8 under 35 U.S.C. § 102(a) and § 102(e) for anticipation by Douglas is affirmed.

The rejection of claim 9 under 35 U.S.C. § 103(a) for obviousness over Douglas is reversed.

Thus, the Examiner's decision that claims 1 and 3-9 are unpatentable over the prior art is affirmed-in-part.

NEW GROUND OF REJECTION

Pursuant to our authority under 37 C.F.R. § 41.50(b) (2008), we are entering the following new ground of rejection.

Claims 1 and 4-9 are rejected under 35 U.S.C. § 101 because they recite subject mater that is not patent-eligible under § 101.

All of the claims are method claims. As explained in *In re Bilski*, 545 F.3d 943 (Fed. Cir. 2008) (en banc):

> The machine-or-transformation test is a two-branched inquiry; an applicant may show that a process claim satisfies § 101 either by showing that his claim is tied to a particular machine, or by showing that his claim transforms an article. *See* [*Gottschalk v.*] *Benson*, 409 U.S. [63,] 70, 93 S. Ct. 253 [(1972)]. Certain considerations are applicable to analysis under either branch. First, as illustrated by *Benson* and discussed below, the use of a specific machine or transformation of an article must

> impose meaningful limits on the claim's scope to impart patent-eligibility. *See Benson*, 409 U.S. at 71-72, 93 S. Ct. 253. Second, the involvement of the machine or transformation in the claimed process must not merely be insignificant extra-solution activity. *See* [*Parker v.*] *Flook*, 437 U.S. [584,] 590, 98 S. Ct. 2522 [(1978)].

Bilski, 545 F.3d at 961-62.

Regarding "insignificant extra-solution activity," the U.S. Court of Appeals for the Federal Circuit has further explained:

> Although the [Supreme] Court spoke of "postsolution" activity, we have recognized that the Court's reasoning is equally applicable to any insignificant extra-solution activity regardless of where and when it appears in the claimed process. *See In re Schrader*, 22 F.3d 290, 294 (Fed. Cir. 1994) (holding a simple recordation step in the middle of the claimed process incapable of imparting patent-eligibility under § 101); *In re Grams*, 888 F.2d 835, 839-40 (Fed. Cir. 1989) (holding a pre-solution step of gathering data incapable of imparting patent-eligibility under § 101).

Id. at 957 n.14.

Furthermore, "[a] requirement simply that data inputs be gathered–without specifying how–is a meaningless limit on a claim to an algorithm because every algorithm inherently requires the gathering of data inputs." *Id.* at 963 (citing *Grams*, 888 F.2d at 839-40). Also, "the inherent step of gathering data can also fairly be characterized as insignificant extra-solution activity." *Id.* (citing *Flook*, 437 U.S. at 590).

Also, as noted in *Bilski*, the *Diehr* Court also held that "mere field-of-use limitations are generally insufficient to render an otherwise ineligible process claim patent-eligible. *See* [*Diamond v. Diehr*,] 450 U.S. [175,] 191-

92, 101 S. Ct. 1048 [(1981)] (noting that ineligibility under § 101 'cannot be circumvented by attempting to limit the use of the formula to a particular technological environment')." *Bilski*, 545 F.3d at 957.

Applying the above principles to claim 1, the "collecting information" steps in claim 1 merely recite the gathering of data and/or insignificant postsolution activity and thus are insufficient to render the claimed process patent eligible under § 101. We find that the claimed gathering of data is not performed by a specific machine, nor is the transformed data directed to a physical object being transformed to a different state or thing. Therefore, the claimed method fails to pass muster under the machine-or-transformation test.

To the extent the step of "incorporating said collected information into a structured relational database" requires recording the collected information, it merely recites insignificant postsolution activity, which is not enough to make the claimed method statutory. *Id.* at 957 n.14. Also, the further requirement of this step that the information be recorded in a structured relational database and the final step of claim 1 ("providing a graphical user interface with a plurality of controls each for initiating a pre-determined query for allowing a user to generate a report indicating reduction of said client barriers over time") fail to "impose meaningful limits on the claim's scope to impart patent-eligibility," as required by *Bilski*. *Id.* at 961. Instead, the effect of these limitations is simply to restrict practice of the method to a computer environment, a restriction that constitutes a field

of use limitation and thus is insufficient to make the claimed method statutory under § 101. *Id.* at 957.

For the foregoing reasons, we conclude that the method recited in claim 1 is unpatentable under § 101. The dependent claims (*viz.*, claims 4-9) likewise fail to "impose meaningful limits" on the scope of the claimed method and therefore also are rejected under § 101.

APPELLANT'S OPTIONS FOR RESPONDING TO THE DECISION AND NEW GROUND OF REJECTION

Regarding the affirmed rejection, 37 C.F.R. § 41.52(a)(1) (2008) provides that "Appellant may file a single request for rehearing within two months of the date of the original decision of the Board" (emphasis added). The date of this decision appears in the caption at page 1.

Regarding the new ground of rejection pursuant to 37 C.F.R. § 41.50(b), that paragraph explains that "[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review." Appellant, within two months from the date of this decision (which appears at page 1), must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

> (1) *Reopen prosecution.* Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the Examiner, in which event the proceeding will be remanded to the Examiner . . . .

(2) *Request rehearing*. Request that the proceeding be reheard under § 41.52 by the Board upon the same record . . . .

37 C.F.R. § 41.50(b) (2008).

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2008).

AFFIRMED-IN-PART; 37 C.F.R. § 41.50(b)

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